

REMARKS

Upon entry of the above amendments, this application will contain claims 1-34 and 37-74 pending and under consideration. The application was originally filed with claims 1-34. In a Preliminary Amendment, claims 35 and 36 were canceled and new claims 40-74 were added. In the present submission, the claims have been further amended. As discussed more fully below, it is believed that the claims are patentable. Reconsideration leading to allowance of all pending claims is requested.

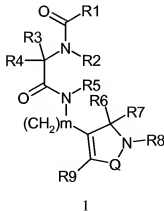
I. Objections to the Specification

Objections were raised to the specification for lack of an abstract. Attached to this submission on a separate page is the Abstract. The abstract, as attached, was included in the first page of the published priority PCT application (WO 03/087069). Therefore, it is believed that this amendment does not add new matter.

II. Provisional Obviousness Double Patenting Rejection

The claims were rejected on the judicially created non-statutory double patenting over the claims of claims 1-20 and 23 -25 of the copending application, serial no. 10/510,393 (publication no. US2005/0240001, hereinafter "Evers '001") and claims 1-28, 30-39 and 41-46 of copending application, serial no. 10/380,867 (now allowed, published as US2004/0058971, hereinafter "Dodge"). Reference was made to the species in claim 25 in Evers '001 and the species in claim 46 of Dodge. The applicants respectfully traverse this rejection.

First, the present application recites in claim 1 to a compound of formula 1:



wherein: R1 through R11 are as recited therein and includes 6 alternative provisos, each independently applicable, at the end of the claim. These are reproduced below:

“provided that R1 is (substituted C₁-C₆alkyl)NHR10 or (unsubstituted or substituted C₃-C₈ cycloalkyl)NHR10; or

R5 is hydroxy, C₁-C₆alkoxy, or substituted C₁-C₆alkyl; or

R6 and R7 are independently unsubstituted or substituted C₁-C₆alkyl or unsubstituted or substituted C₂-C₆alkenyl with the proviso that at least one group is substituted; or

R6 is hydrogen and R7 is substituted C₁-C₆alkyl or substituted C₂-C₆alkenyl; or

R6 and R7 together with the carbon atom to which they are attached form a substituted C₃-C₈ cycloalkyl group which is optionally partly unsaturated; or

R8 is substituted C₁-C₆alkyl, substituted aryl, unsubstituted or substituted (C₁-C₆alkyl)C₃-C₈cycloalkyl or substituted C₁-C₆alkylaryl;”

A comparison of the provisos listed above and elements recited for R1, R5, R6, R7, and R8 in the allowed claims of Dodge will demonstrate that presently claimed invention and that of Dodge are not the same and that each of the provisos in present claim 1 will operate to distinguish the presently claimed invention from that of Dodge. Compounds of the present invention include the features prescribed in at least one of the 6 alternative provisos in Claim 1.

The species recited in claim 46 of Dodge is 2-(R)-2-(2-Amino-2-methylpropionylamino)-3-phenylmethoxy propionic acid N-(5-(4-chlorophenyl)-3,3-dimethyl-1,1-dioxo-2,3-dihydroisothiazol-4-ylmethyl)-N-ethylamide. Taking each proviso in turn: This species is not within the first proviso of claim 1 because the 2-amino-2-methylpropionylamino at the R1 locus is not a (substituted C₁-C₆alkyl)NHR10 or (unsubstituted or substituted C₃-C₈ cycloalkyl)NHR10 group. It is highlighted that “substituted C₁-C₆alkyl” as defined according to page 15 lines 25-29 of the published PCT application as filed does not include the possibility for alkyl substituted C₁-C₆alkyl groups.

This species is not within the second proviso of claim 1 because the ethyl group at the R5 locus is not hydroxy, C₁-C₆alkoxy, or substituted C₁-C₆alkyl.

This species is not within the third proviso of claim 1 because the methyl groups at the R6 and R7 loci are not unsubstituted or substituted C₁-C₆alkyl or unsubstituted or substituted C₂-C₆alkenyl with the proviso that at least one group is substituted.

This species is evidently not within the forth or fifth proviso of claim 1 due to the definitions for R6 and R7.

This species is not within the sixth proviso of claim 1 because the hydrogen atom at the R8 locus is not substituted C₁-C₆alkyl, substituted aryl, unsubstituted or substituted (C₁-C₆alkyl)C₃-C₈cycloalkyl or substituted C₁-C₆alkylaryl.

Thus, the provisos serve to distinguish this species from those presently claimed. In light of the above comments, withdrawal of the non-statutory double patenting over Dodge of claim 1 and claims 2-38 and 45-74, which depend directly or indirectly from claim 1, and of claims 39-44, which include one or more of the same elements for R1, R5, R6, R7, and R8 as described above, is requested.

Consider now Evers '001. The applicants will submit an acceptable terminal disclaimer in the present application or that of Evers '001 whichever is found to be allowable last.

III. Rejections Under 35 USC § 112

Claims 1-34, 37, 38, 41-44, and 45-74 are rejected under U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 1, the word "or" was inadvertently left out before the last entry in the definitions of R3, R5, and R6 and R7. Similar omissions were noted for the remaining claims. The claims have been amended to include either "or" or "and". Withdrawal of this rejection is requested.

2) Claims 25, 47, 53, 59, 65, and 71 were rejected for including new sentence within the claims. The claims have been amended by deleting the recited preferred substituted aryl moieties. In addition, the parenthetical phrase "(preferably chloro or fluoro)" was also removed from the claims.

3) Claims 29, 50, 56, 62, 68, and 74 were rejected for lack of antecedent basis for the "thiazolyl, pyridyl and oxazolyl" moieties. The claims have been amended by deleting these species from the list for R9.

4) Claim 34 was rejected for omission of the term claim in the last line. Claim 34 has been amended.

5) Claims 37, 38, and 41-44 were rejected for reciting to a method comprising administrating. The claims have been amended as suggested by in the Office Action. (Office Action, page 7.)

6) Claims 41 and 43 were rejected for the minor typographical error using "effect" instead of effective. These claims have been amended.

In addition, the word "claim" preceding each claim has been deleted.

When present the terms "or solvent" has also been deleted. It is believed that use of the open transitional word "comprises" will include additional component such as solvents.

In light of the above noted amendments, withdrawal of the rejections is requested.

IV. Rejections Under 35 USC § 102

1) Claims 1, 5, 22-32, 27, 38 and 63-68 were rejected under 35 U.S.C. 102(c) alleged for being anticipated by WO 02/32888 (hereinafter “Dodge”). The applicants respectfully traverse this rejection. As noted above claim 1 recites six (6) individual or separate provisos applicable to groups R1, R5, R6 and R7 (combined), and R8 (see lines 30-39). When claim 1 is read in its entirety, it is maintained that Dodge does not anticipate nor make obvious the claimed invention.

It should also be noted that:

claim 2 specifically recites the proviso for R5;

claim 3 specifically recites the proviso for R8;

claim 4 specifically recites the three provisos for R6 and 7 (combined); and

claim 5 specifically recites the proviso for R1.

It was specifically alleged that the compound illustrated as Example 1 of Dodge anticipates the claimed invention. It is respectfully submitted that this is not correct. If one considers the chemical groups in the species of Example 1 of Dodge at the R1, R5, R6, R7 and R8 loci as defined in the present invention (formula I) against the 6 provisos (similar to the consideration above for claim 46 of Dodge), it can be seen that such a compound does not have the necessary conformance of features to be within any one of the provisos so will not be within the claim. For ease of reference, in Example 1 of Dodge, R1 = *unsubstituted* C₁-C₆ alkyl)NHR10, *i.e.*, the alkyl = -C(CH₃)₂; R5 = *unsubstituted* alkyl *i.e.*, ethyl; R6 and R7 = an *unsubstituted* C3-C8cycloalkyl group, *i.e.*, a cyclohexyl ring; R8 = an *unsubstituted* alkyl group, *i.e.*, methyl.

Claim 22 depends from claim 1 describes a compound of Formula II in which the m in Formula 1 is 1. Consequently it is believed that claim 22 is not anticipated or made obvious by Dodge.

Claims 23-26 each depend from claim 1 and further define R3. Claim 27 depends from claim 1 and further defines R4. Claims 28 and 29 depend from claim 1 and further define R9, Claims 30 and 31 are directed to formulations that include the compound of claim 1. Claim 32 is directed toward a process for preparing a compound of Formula I. Claims 37 and 38 are directed to a method of treating animals that comprises administering a compound of claim 1. Claims 63-68 are directed to the compound according to claim 5 (and thence to claim 1). As noted above, claim 5 is not anticipated by Dodge.

In light of the above comments, withdrawal of the rejections of claims 1, 5, 22-32, 27, 38, and 63-68 is requested.

V. Rejections Under 35 USC § 103.

Claims 1, 3-5, 10-32, 37, 38 and 51-74 were rejected under 35 U.S.C. 103(a) over Dodge. The applicants respectfully traverse this rejection and request withdrawal of the rejection pursuant to 35 USC §103(c).

Dodge is the national stage entry of PCT/US01/27756, filed on 9 Oct. 2001 and published on 25 Apr. 2002 as WO02/32888. The present application is the national stage entry of PCT/US03/08680 filed on 31 Mar. 2003 (published as WO04/0058936) and claiming priority to US Provisional patent application nos. 60/371,271; 60/371,270; 60/371,278; 60/371,275; and 60/371,277 all filed on 9 Apr. 2002—prior to the earliest publication date of Dodge. Thus, Dodge is not prior art under §102(a), (b), (c) or (d). Further, the subject matter of Dodge and the present claimed invention were, at the time that the claimed invention was made, subject to an obligation of assignment to Eli Lilly and Co. In support thereof, reference is made to the assignment for Dodge executed in June 2001 and recorded at reel/frame 017928/0291 and the assignment of the present invention also to Eli Lilly and Co. executed in March 2003 and recorded at reel/frame 016892/0564.

In light of the above, withdrawal of the rejections of claims 1, 3-5, 10-32, 37, 38 and 51-74 is requested.

VI. Conclusion

Applicants respectfully request timely examination of this application leading to allowance of all elected claims. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Response or other issues that may be resolved in that fashion.

Respectfully submitted,

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November 17, 2006